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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,159	04/23/2001	Jay S. Cantwell	04212.00001	3381

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EXAMINER

LIN, ING HOUR

ART UNIT	PAPER NUMBER
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1722

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DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/839,159

Applicant(s)
Cantwell

Examiner
Ing-Hour Lin

Art Unit
1722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 23, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-35 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-35 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Apr 23, 2001 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3

20) ☐ Other:

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Part III DETAILED ACTION

Drawing

1. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 31 and 35, should "a part" be --apart--? In claim 20, line 1, "the method of claim 19" is not understood. In claim 31, "said article", "the casting process", and "the cast" lack antecedent basis. "gate depressions" in claims 22-24 and

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"an opening at an edge of said carrier strip" in claims 26 and 30 are not supported in the specification. "said marker depressions" in claim 25 and "said runner depressions" in claim 29 lack antecedent basis. In claim 35, "said article", "the molding process", and "the mold" lack antecedent basis.

double patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 31-34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 31-34 and 66 of copending Application No. 09/986,659. This

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is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

103 rejection

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-18, 22-32 and 35 are rejected under 35 § 103(a) as being unpatentable over CH 683073 in view of Darovec.

CH '073 (see abstract) teaches the claimed identification stencil (binary code identification label) and process of for uniquely identifying a plurality of cast or mold articles using a binary code number integrally cast or molded into each of said articles during a casting or molding process, comprising: providing a binary code identification stencil (binary code identification label) having voids for filling code

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identification formed by depressions or cut-through (stamped and embossed) processes, attaching the stencil (label) to an interior surface of a casting or mold used to casting or molding the articles; and filling the mold with casting or molding material in order to form a relief identity on the cast or molded articles, wherein the stencil (label) is attached (fixed) to the mold surface using adhesive or stapling.

CH '073 fails to teach the use of a marker with a machine readable bar code.

However, Darovec (col. 1, lines 67+ and Fig. 1) teaches the use of a marker with a machine readable bar code on a rectangular uniform strip, wherein each of the markers formed selected code element location are parallel to each other and of the same length. Further, Darovec also teaches the use of human readable symbols (Fig. 1) which corresponding to the identification code for the purpose of effectively uniquely identifying a plurality of cast or molded articles.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided CH '073 with the use of a marker with a machine readable bar code on a rectangular uniform strip as taught by Darovec in order to three-

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dimensional (relief) machine readable bar code depressions and human readable symbols depressions on a rectangular uniform strip and effectively uniquely identify a plurality of cast or molded articles.

With respect to claims 10-13, CH '073 in view of Darovec fails to teach fiber reinforced material and withstanding materials of high temperature, high pressure and vacuum. However, the fiber reinforced material and withstanding materials for the strip of the stencil would have been obvious to one of ordinary skill in the art in order to effectively uniquely identify a plurality of cast or molded articles processed in high temperature, high pressure or vacuum condition.

With claims 22-26 and 29-30, CH '073 in view of Darovec fails to teach runner and gating depressions. However, the use of runner and gating depressions and connecting the depressions to the end of each code marker depressions and each human readable symbols depressions would have been obvious to one of ordinary skill in the art for the purpose of uniquely identifying a plurality of cast or molded articles having clear relief identity.

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8. Claims 19-21 and 33-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CH '073 in view of Darovec and further in view of Edwards.

CH '073 in view of Darovec fails to teach a particular attachment material.

However, Edwards (col. 3, lines 17+) teaches the use of a layer of poly acrylate as an attachment material and a layer of unvulcanized rubber as a barrier (protect layer) in fixing of shaped bodies to metal casting molds for the purpose of effectively attaching the shaped bodies to the mold surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided CH '073 in view of Darovec with use of a layer of poly acrylate as an attachment material and a layer of unvulcanized rubber as a barrier (protect layer) as taught by Edwards in order to effectively attaching the strip to the mold surface.

Conclusion

9. Any inquiry concerning this communication or earlier

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communications from the examiner should be directed to Examiner I.-H. Lin whose telephone number is (703) 308-3442 or Supervisor Nam Nguyen whose telephone number is (703) 308-3322.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

I.-H. Lin *I.H.L.*

March 4, 2002

KUANG Y. LIN
EXAMINER
GROUP 320

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